

CLAIM 83

Claim 83 depends from claim 82 and therefore distinguishes from Fabel and from the 7.1.1 facts. In addition claim 83 has the following recitals not found in Fabel or the 7.1.1 facts:

that utilizes feeding mechanisms that contact said envelopes at mechanism contact points up to approximately one and a half inches from a bottom edge of said envelopes, and a delivery point barcode positioned on at least one of said envelopes and spaced from said mechanism contact points.

CLAIM 84

Claim 84 depends from claim 83 which depends from claim 82, and is therefore distinguished from Fabel and from the 7.1.1 facts, for the reasons given for each of those claims, and in addition has the following recital not found in Fabel or the 7.1.1 facts:

wherein barcodes are on both the outgoing and reply envelopes at positions spaced from said mechanism contact points.

CLAIM 85

Claim 85 depends from claim 82 and distinguishes for the reasons given above in support of claim 82, and in addition calls for different weights for different components and this too is not in Fabel or in the 7.1.1 facts.

CLAIM 86

Claim 86 depends from claim 85 which in turn depends from claim 82, and is therefore patentable for the reasons given above in support of claims 82 and 85, and in addition recites the specific weights of the paper. These weights are patentable since they enable an ordinary impact printer to not only print details such as a bar code and other writing on the return envelope but enables the overall envelope system to withstand all of the beating given to it

throughout its useful life.

CLAIM 87

Claim 87 patentably distinguishes from Fabel and from the 7.1.1 facts, by reciting the following:

providing said envelopes with adjacent contrasting colors including a rectangular area whose color is relatively light and a contiguous area that is relatively dark, and
printing said addresses in said relatively light colored areas, and

CLAIM 88

Claim 88 patentably distinguishes from Fabel and from the 7.1.1 facts, by reciting:

reinforcing said right-hand edge to thereby reduce the possibility that said machinery will seriously damage the first envelope.

In contrast, Fabel "teaches away" from this claim, see col. 11, lines 7-10, and col. 14, lines 57-59, of Fabel.

CLAIM 89

Claim 89 depends from claim 88 and adds the following:

said step of providing sheets attached and reinforced along the right-hand edge comprises gluing said sheets together along their right-hand edges.

CLAIM 90

Claim 90 patentably distinguishes from Fabel and from the 7.1.1 facts, by reciting the following:

said right-hand edge being stronger than the other said edges.

CLAIM 91

Claim 91 patentably distinguishes from Fabel and from the 7.1.1 facts, by reciting the following:

means adjacent said lower end, for opening said envelope,

said reply envelope having a lower end that is open when the reply envelope is in the outgoing envelope, said flap being positioned closely adjacent said means when the reply envelope is in the outgoing envelope.

CLAIM 92

Claim 92 distinguishes patentably over Fabel and from the 7.1.1 facts, for the reasons given for claim 91 and since it recites:

said tear strip having an end adjacent said left edge that may be pulled toward said right edge to open the outgoing envelope.

Moreover, Fabel does not have a reply envelope, the lower end of which is open. Fabel does not have a tear strip.

CLAIM 93

Claim 93 patentably defines over Fabel and from the 7.1.1 facts, by the following recital:

said step of providing a reply envelope comprising providing said reply envelope with a top end that is adjacent said upper edge of said outgoing envelope, providing a carbonized area contiguous with an area of said reply envelope that is near said top end of said reply envelope so that the customer's address that was printed on said cover sheet will appear near said upper edge of said reply envelope.

Fabel uses the same envelope as the outgoing and the reply envelope, see col. 7, lines 45-49 and col. 14, lines 49, et seq.

CLAIM 94

Claim 94 depends from claim 93 and is patentable over Fabel and from the 7.1.1 facts, since it calls for:

providing a carbonized area adjacent a portion of said billing statement to enable printing of said customer's name and address on said billing statement.

CLAIM 95

Claim 95 depends from claim 91 and is patentable for the same reasons as claim 91, and also has the following limitation which adds

more patentability to the claim:

a tear strip having a free end adjacent the lower left end of said back side so that said free end may be pulled toward the lower right end of said back side to open the envelope, whereby the direction that said tab is pulled is opposite to the direction that the outgoing envelope passes through the postal service's processing machinery.

When the tear strip is at the top of the outgoing envelope it makes little difference whether it is pulled from left to right or from right to left. But, where the tear strip is within the lower $1\frac{1}{2}$ inches of the bottom of an envelope it may be damaged by the machinery used by the United States Postal Service. To avoid this possible damage, claim 95 calls for a tear strip that is pulled in the direction opposite that in which the envelope travels through the postal service's machinery.

CLAIM 96

Claim 96 patentably distinguishes over Fabel and from the 7.1.1 facts, by the following recitals:

means adjacent said lower end, for opening said envelope,

said means having a free end movable from a position adjacent the lower left end of said back side toward a position adjacent the lower right end of said back side to open the envelope, whereby said free end is pulled, during the opening of the envelope, in a direction opposite to the direction that the envelope goes through the processing machinery of the postal service.

CLAIM 97

Claim 97 patentably distinguishes over both Fabel and from the 7.1.1 facts by the following recitals:

positioning a carbonized area over each said area of each said envelope,

positioning said areas of said sheets, so that when the address of the sender of the outgoing envelope is applied to the originating sheet by impact printing it will appear as the sender of the outgoing envelope and the addressee of the return envelope,

CLAIM 98

Claim 98 depends from claim 97 and is therefore patentable over Fabel and from the 7.1.1 facts, for that reason. In addition claim 97 distinguishes patentably from Fabel and the 7.1.1 facts by reason of the following recitals:

and printing a barcode on at least one of said envelopes positioned in spaced relation to said contact points.

CLAIM 99

Claim 99 depends from claim 93 and is patentable over Fabel and from the 7.1.1 facts, for the reasons given for patentability of claim 93, in addition to the following:

includes printing a FIM mark on said cover sheet, and providing a carbonized area for reproducing said printed FIM mark on said reply envelope.

CLAIM 100

Claim 100 defines patentably from Fabel and from the 7.1.1 facts, by the following recitals:

providing a first area of said reply envelope for the address of the sender of the reply envelope,
providing a medium contiguous with said first area of said reply envelope for applying the address, of the sender of said reply envelope, to said reply envelope,
providing a second area of said reply envelope for the addressee of the reply envelope,
providing a medium contiguous with said second area of said reply envelope for applying the addressee of the reply envelope to that envelope,
providing a third area of said reply envelope for the FIM mark,

CLAIM 101

Claim 101 depends from claim 100 and has the following in addition to the reasons given for the patentability of claim 100:

each of said first and second areas have a medium contiguous thereto enabling the impact printing to apply said addresses to first and second areas.

CLAIM 102

Claim 102 defines patentably over Fabel and from the 7.1.1 facts, in view of the following:

said first sheet having a solid opaque area on its inside face and directly behind each said area of said outside face, and

means on the inside face of said first sheet for providing security screening of all of the area of said inside face that does not have an opaque coating.

CLAIM 103

Claim 103 depends from claim 102 and is patentable for both the recitals of claim 102 and the following:

said envelope is the reply envelope of a postal envelope system having an outgoing envelope with said reply envelope in said outgoing envelope.

CLAIM 104

Claim 104 distinguishes patentably over Fabel and from the 7.1.1 facts, by reason of the following:

providing said billing sheet with a line of weakness so that it may readily torn apart into first and second pieces,

said printing step printing billing information including the name and address of both the sender and the receiver of said outgoing envelope on one of said pieces and the name and address of said sender and receiver on the other one of said pieces.

CLAIM 105

Claim 105 is not found in Fabel or in the 7.1.1 facts, by reason of the foregoing quotation from claim 82 plus the following:

said reply envelope has an open end adjacent said bottom edge.

CLAIM 106

Claim 106 depends from claim 105 which in turn depends on claim 82. Claim 106 is therefore patentable over Fabel and from the 7.1.1 facts, by reason of the above recitals of claims 82, and 105,

as well as the following:

reply envelope has a flap for closing said open end.

CLAIM 107

Claim 107 depends from claim 82 and is patentable since it calls for the following in combination with the recitals of claim 82.

said originating sheet having first and second areas both adjacent said top edge for said mail-to and said return addresses respectively,
said originating sheet also having third and fourth areas for said mail-to and said reply addresses respectively.

CLAIM 108

Claim 108 depends from claim 107 which in turn depends from claim 82. Claim 108 is patentable since the recitals of claims 82, 107 and 108 form a new combination not found in Fabel or in the 7.1.1 facts.

outgoing envelope has a bottom edge and also in which said reply envelope has an open end adjacent said bottom edge.

Miscellaneous

CLAIM 109

Claim 109 distinguishes patentably over Fabel and from the 7.1.1 facts, by reason of the following:

said first sheet having one or more areas on which information may be printed, on the outside face of said first sheet,
said first sheet having a solid opaque area on its inside face and directly behind each said area of said outside face.

Reference is made to paragraph 7 et seq. relating to Obviousness, starting on page 4 of the Official Action of June 24, 2002. In par. 7.1.1, the Examiner relied on "applicant's admitted prior art." Applicant assumes that the so called "admitted prior

art" is the four items recited in paragraph 7.1.1.

The issue of obviousness, however, requires that the secondary references supply all of the elements of the claims not found in the primary reference. As stated in MPEP 2142 it is said:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (Emphasis added)

Conceding, as we do, the four prior art facts set forth in said par. 7.1.1, the elements (of the claims) which are quoted on pages 2 to 9, supra, are still not found in Fabel or in said par. 7.1.1.

A few examples will show that the claims are clearly patentable.

In the prior art it is customary to have two printing (or typing) operations to place one of the addresses on both the outgoing and reply envelopes, whereas Applicant has devised a postal system in which one simple impact printer can apply all of the addresses with one impact stroke. Claims 82, 83, 84, 85, 86, 105, 106, 107, and 108, all call for the way the outgoing and reply envelopes are printed and this has no direct relation to the four facts set forth in said par. 7.1.1.

Claim 87, relates to improving the readability of printed material and is in no way suggested or motivated by the four facts in

said paragraphs 7.1.1. Further, there isn't anything in said paragraphs 7.1.1, that teaches how to improve readability.

Claims 88, 89, and 90 refer to the leading edge of the envelope. Fabel teaches away from these claims since he teaches that the way to strengthen the envelope is to reinforce the edges of a window that is near the middle of the envelope. It is well settled that when one element of a claim for a combination is not taught by a reference which teaches away from the invention, such reference cannot be combined with another reference to render the claim obvious.

Fabel does not have a reply envelope in the sense the term is used in the present case. Indeed, Fabel teaches away from the general concept of a reply envelope.

Claims 91 and 92 calls for the flap of the reply envelope to be adjacent the lower end of the envelope.

By having the flap of the reply envelope and the tear strip at the lower end of the back side of the outgoing envelope, it is possible to have more space on the reply envelope to print addresses etc. In an ordinary prior art reply envelope the flap and the tear flap are at the top of the outgoing envelope and therefore the width of those parts is not available for printing addresses. Further, printing is not available for that part of the prior art reply envelope that is within the $1\frac{1}{2}$ inch band which the USPS's processing machinery engages. Therefore, in the prior art the space available for printing is limited at both the top and the bottom. But if the flap and the tear strip are at the lower end, everything above the lower $1\frac{1}{2}$ inches is available for printing, a much wider space than in

the prior art.

Hence, the parts that might limit the space for printing on the reply envelope, namely the "means" for opening the envelope and the flap are at the lower part of the outgoing envelope.

Fabel "teaches away" from the above concept because the part of his device which are used as a reply envelope are not upside down, with a flap near the bottom. The flap, if any, is at the side.

With reference to claims 102 and 103, security screening is well known. However, Applicant has found that such security screening may cause erroneous readings by a machine that reads addresses. That problem has not been taught by any known prior art. The inventions of claims 102 and 103 overcome this problem.

New claims 110 and 111 depend from claims 91 and 92 respectively and add patentable subject matter by reciting the width of the "means" (claim 110) and the "tear strip" (claim 111).

Respectfully submitted,



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